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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,235	08/21/2003	Mahmoud F. Abdelgany	SPINE 3.0-298 DIV I	7163
530 7590 07/19/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER PRIDDY, MICHAEL B	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 07/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/645,235

Applicant(s)

ABDELGANY ET AL.

Examiner

Michael B. Priddy

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-40 and 42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-40 and 42 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Applicant has argued that the previously withdrawn claims 6, 7, 16, 18, 19, 25 and 30-32 are readable on the elected species depicted in Figure 1. After reviewing these claims in view of Figure 1, the Examiner is in agreement with Applicant. Claims 6, 7, 16, 18, 19, 25 and 30-32 have been treated on their merits in the action which follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11-37, 39, 40 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Duvillier et al. (US Patent Number 5,749,876).

Duvillier et al. disclose various embodiments of a bone graft forming guide for providing a bone graft having a desired shape comprising a main body, 14, 21, 24 (block) & 61, with a guide receiving opening, 19, and protrusions, e.g. 16, a holder, 28, an insertable hole guide, 46, containing a plurality of linear hole guides, 49, arranged in a pattern generally corresponding to the desired shape of the bone graft, and an insertable cutting guide, 30, containing slots, 31, hinged portions at 37 on 24 and 19 on 14 and a

clamping mechanism, 61 (see various embodiments in figures 2 and 3), said body further comprises a mounting structure 61 to facilitate detachably mounting said cutting guide to said body and a securing element 18 to secure said cutting guide to said mounting structure. Regarding claim 11, the body includes a first member, e.g. 21 and a second member, e.g. 24, pivotally connected to one another (see figure 2 and column 7, lines 40-65).

Concerning the language of claims 1, 5, 27 and 42 requiring the hole pattern "allowing for holes to be made along first and second spaced apart portions of the perimeter of the bone graft," it is noted that hole guide 46 could simply be moved from one portion of the perimeter to the other to allow for holes to be made along the first and second spaced apart portions of the perimeter of the bone graft.

Concerning the language of claims 1 and 5 requiring the cutting pattern "allowing for cuts along at least first and second spaced apart portions of the perimeter of the bone graft," it is noted that the cutting guide 30 could simply be moved from one portion of the perimeter to the other to allow for cuts to be made along the first and second spaced apart portions of the perimeter of the bone graft.

Concerning the language of claims 16 and 25 requiring the plurality of bores be interconnected, the Examiner's position is that the plurality of bores are interconnected by virtue of the fact that the bores are all formed in the same plate which interconnects them.

It is noted that the preamble of claims 1 and 5 recites. "A bone graft forming guide for providing a bone graft having a desired shape" and the preamble of claims 11,

27 and 42 recites "An instrument for use in forming a bone from bone graft material", both of which amount to an intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Furthermore, with regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Duvillier et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 45.8, 459 (CCPA 1963). Moreover, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983).

Claim Rejections. 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Duvillier et al. (US Patent Number 5,749,876). Duvillier et al. disclose the claimed invention except the outline being arcuate. It would have been an obvious matter of design choice to one

skilled in the art at the time the invention was made to construct the device of Duvillier et al. having an arcuate outline, since it is just one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing various shaped bone grafts. In re Dailey and Eilers, 149 USPQ 47 (1966).

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 7 has been interpreted as invoking 35 U.S.C. 112 6th paragraph 'means plus function' language which is required to be interpreted as the element disclosed in the specification or its full functional equivalent. Neither Duvillier et al. or any of the prior art of record teach or fairly suggest the means claimed or its functional equivalent.

Response to Arguments

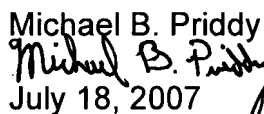
Applicant's arguments with respect to claims 1, 5, 11, 27 and 41, filed 05/29/2007 have been fully considered but they are not persuasive. The Examiner feels these issues are adequately addressed in the above modified rejection under 35 USC 102(b).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy

July 18, 2007


EDUARDO C. ROBERT
SUPERVISOR, PATENT EXAMINER